

S.C.

**Notice of Allowability**

Application No.

10/054,742

Examiner

Kuo-Liang Peng

Applicant(s)

GUNATILLAKE ET AL.

Art Unit

1712

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 9/10/04 Amendment.
2. ☒ The allowed claim(s) is/are 95-98 and 153.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |   |  |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)  | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                              |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date <u>0904</u> . |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment                                      |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material          | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance                     |
|   | 9. <input type="checkbox"/> Other _____.   |

### **DETAILED ACTION**

1. Applicants' amendment filed on September 10, 2004 was received. Claim 153 is amended. Claims 1-94, 99-152 and 154-157 are deleted. Now, Claims 95-98 and 153 are pending.

#### ***Examiner's Amendment***

2. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

3. Authorization for this examiner's amendment was given in a telephone interview with Mr. William F. Prout on September 28, 2004.

The application has been amended as follows:

In Claim 153 (line 2), delete "according to claim 83".

In Claim 153 (line 3), delete "under (A) below, or a reaction product of (b), (c) and (d) as set out under (B)".

In Claim 153 (line 4), delete "(A)".

In Claim 153 (line 6), replace "and-" with -- and --.

In Claim 153, delete whole lines starting from line 14 to line 20, (i.e., from “(B) (b) a diisocyanate .....300 to 700; and”).

In Claim 153 (line 21), replace “wherein the silicon-based macrodiol is a silicon-based polycarbonate having the” with --wherein the silicon-based macrodiol and macrodiamine are silicon-based polycarbonates having the --.

In Claim 153, above line 8 (counted from bottom of the claim)(i.e., above “m, y and z are ....), insert -- A and A’ are as defined in formula (I); --.

4. Claim objection(s) in the previous Office Action (Paper No. 0504) is/are moot.
5. Claim rejections under 35 USC 112 in the previous Office Action (Paper No. 0504) is/are removed.
6. Claim rejections under 35 USC 102 and 103 in the previous Office Action (Paper No. 0504) is/are moot.

***Allowable Subject Matter***

7. Claims 95-98 and 153 are allowed.

8. The following is an examiner's statement of reasons for allowance:

The present claims are allowable for at least the following reason(s) over the closest references: Gunatillake (WO 99/03863), Ito (JP 63-179916), Meijjs405 (WO 98/13405), Lee (US 5 911 737) and Ward (US 5 814 705).

None of the aforementioned references, taken alone or in combination, teaches or fairly suggests the use of the silicon-based polycarbonate represented by formula (IV) for making a shape memory polyurethane or polyurethane-urea polymer in the present invention.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

Art Unit: 1712

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp  
September 30, 2004

  
**KUO-LIANG PENG**  
**PRIMARY EXAMINER**

Kuo-Liang Peng  
Primary Examiner  
Art Unit 1712